

**REMARKS**

Initially, Applicant would like to thank Examiners Padmanabhan and Yu for the courteous and helpful Interview conducted November 2, 2005, which, Applicant believes, materially advanced prosecution in this case.

Claims 103-112 have been added. Regarding claims 103 and 107, Applicant notes that non-alkoxylation is a well-known inherent property or characteristic of the silicone compounds identified in the present application such as, for example, dimethicone and phenyl trimethicone. Accordingly, claims 103 and 107 which are directed to such well-known inherent properties or characteristics of disclosed silicones are properly supported by the present specification. *See, In re Nathan*, 328 F.2d 1005, 1009 (CCPA 1964).

Claims 1, 52, 59 and 96-100 have been canceled.

Claims 2-28, 31-42, 44-51, 53-58, 60-79, 81-95 and 101-112 are currently pending, although claims 53-57, 60 and 61 have been withdrawn from consideration.

In view of the above amendments, all but two of the claims require the presence of from 0 to about 5% by weight of the total weight of the composition of a volatile oil. Support for such claims exists, *inter alia*, at page 19, line 23. The two remaining claims, claims 111 and 112, require the presence of 0-2% volatile oil. (See, page 19, line 23 of the present specification for support).

The Office Action rejected independent claims 1 and 52 (as well as all claims depending therefrom) under 35 U.S.C. § 112, second paragraph, as being indefinite with respect to the amount of volatile oil present. In view of the above amendments to the claims, Applicant respectfully submits that the § 112 rejection has been rendered moot and should be withdrawn.

The Office Action also rejected the pending claims under 35 U.S.C. § 103 as obvious over (1) U.S. patent 5,738,841 (“Mellul”) in view of U.S. patent 5,690,918 (“Jacks”), U.S. patent 6,126,951 (“Fogel”) and/or JP 63119412 (“JP 412”); and (2) EP 0548694 (“Nojima”) in view of Mellul. In view of the following comments, Applicant respectfully requests reconsideration and withdrawal of these rejections.

Nowhere does the cited art teach, suggest or motivate one skilled in the art to produce a transfer-resistant composition, particularly a lipstick, containing little or no volatile oil (5% or less) using the required ingredients in the required concentrations.

Regarding the rejections based on Mellul, Jacks, Fogel, and/or JP 412, Mellul does not relate to transfer-resistant compositions, let alone transfer-resistant lipsticks. Rather, Mellul discloses non-transfer-resistant compositions containing 0% inert particulate phase or 48% or more inert particulate phase,<sup>1</sup> and teaches that volatile silicone oils are interchangeable with non-volatile silicone compounds. (See, col. 2, line 51). One skilled in the art, seeking to produce a composition addressing appearance and sensation problems associated with transfer-resistant compositions, particularly lipsticks, would not be motivated by Mellul to selectively combine the required ingredients in the required proportions with the expectation that the resulting composition would be a transfer-resistant composition, particularly a transfer-resistant composition having desirable properties such as not having a matte appearance or a sensation of dryness, tautness and/or discomfort.

Neither Jacks, Fogel, nor JP 412 suggests modifying Mellul’s compositions to yield transfer-resistant compositions, particularly lipsticks, containing particulate

---

<sup>1</sup> In this regard, Applicant notes that pigments do not constitute fillers/inert particulate phase. (See, specification at pages 20 and 21; Mellul at col. 2, line 43).

matter, non-volatile silicone compounds and volatile oil in the required concentrations.

Jacks relates to transfer-resistant compositions. Typically in such compositions, volatile oil evaporates after composition application. After the volatile solvent/oil has evaporated, the remaining composition forms a dry, transfer-resistant film. Thus, the presence of volatile solvent and its evaporation from the applied formulation enables the formation of transfer-resistant films. Jacks recognizes this crucial role volatile oils play in his transfer-resistant compositions, stating that volatile oils contribute to the “wear characteristics” of his compositions. (Col. 4, lines 10-11). This is presumably why Jacks teaches and exemplifies that substantial amounts of volatile oil should be present in his compositions, most preferably between 40-50%. (Col. 4, line 38).

One of the primary practical differences between the claimed invention and Jacks is that the claimed invention permits formation of a transfer-resistant film using a composition containing little or no volatile oil, whereas Jacks requires the presence of a substantial amount of volatile oil. One skilled in the art, seeking to create a transfer-resistant film, would not be motivated by Jacks to remove or reduce volatile solvent because removing volatile solvent would affect the wear-characteristics of these transfer-resistant products. In other words, one skilled in the art would be led away from the claimed invention.

Fogel does not compensate for Mellul’s deficiencies either. Fogel teaches that volatile silicones should be replaced with moisturizers/emollients which will not evaporate like volatile silicones. (Col. 1, lines 5-30). One skilled in the art, seeking to produce a transfer-resistant composition, would not be motivated to make such a

substitution because transfer-resistant compositions (like Jacks's) typically required evaporation of a volatile oil to occur so that a transfer-resistant film would be formed. Replacing a volatile oil with a non-volatile oil would defeat such a purpose.

JP 412, which is cited merely for its disclosure relating to 12-hydroxystearic acids, cannot compensate for Mellul's deficiencies as well.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of these § 103 rejections.

Regarding the § 103 rejection based upon Nojima and Mellul, no motivation would have existed to combine Nojima and Mellul to yield the invention compositions. Nojima requires the presence of alkoxyated silicones. Mellul, on the other hand, is directed to "surprisingly" homogenous mixtures of octyldodecyl neopentanoate and "at least one silicone-containing compound which may be chosen from silicone oils, gums and/or waxes." (Col. 2, lines 48-49). Mellul neither teaches nor suggests that her silicones could be alkoxyated and, in fact, teaches away from such alkoxyated silicones by identifying only non-alkoxyated silicones as being suitable for combination with octyldodecyl neopentanoate. (Col. 2, line 49 through col. 3, line 6). One skilled in the art, following the teachings of both of these references, would not have been motivated to combine them given the highly specific nature of their disclosures: Nojima relates only to alkoxyated silicones, while Mellul relates to "surprisingly" homogeneous compositions containing non-alkoxyated silicones. Given the specificity of their disclosures, nothing in either of these references would have suggested that non-alkoxyated silicones could be used in Nojima's compositions or that alkoxyated silicones could be used in Mellul's

compositions to yield a "surprisingly" homogeneous composition. For this reason alone the § 103 rejection is improper and should be withdrawn.

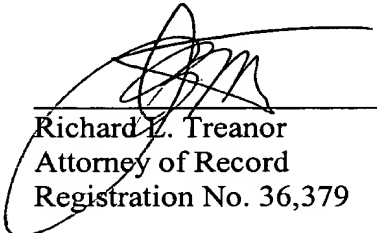
Moreover, claims 28, 79, 104 and 108 require the presence of specific silicone compounds. Nojima neither teaches nor suggests the specific silicones required in these claims. As noted above, Mellul neither teaches nor suggests transfer-resistant compositions. Accordingly, the combination of Nojima and Mellul cannot suggest the claimed transfer-resistant compositions containing the required silicones in these claims. For this reason as well, claims 28, 79, 104 and 108 are free of the cited art.

In view of the above, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 U.S.C. § 103.

Applicant believes that the present application is in condition for allowance. Prompt and favorable consideration is earnestly solicited.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,  
MAIER & NEUSTADT, P.C.



---

Richard L. Treanor  
Attorney of Record  
Registration No. 36,379

Jeffrey B. McIntyre  
Registration No. 36,867

Customer Number

**22850**

Tel #: (703) 413-3000  
Fax #: (703) 413-2220